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| 10/828,912 | 04/20/2004 | Stephen Russell Falcon | MS1-1946US | 5652 |

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| EXAMINER | |
|---|---|
| NEWAY, SAMUEL G | |

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| 2626 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/828,912 | FALCON ET AL. | |
| | Examiner | Art Unit | |
| | SAMUEL G. NEWAY | 2626 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *21-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. This is responsive to the RCE filed on 22 May 2009.

2. Claims 21-31 are pending and considered below. All the pending claims are new.

### *Response to Arguments*

3. Applicant's arguments with respect to claims 21-31 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 21-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 21 recites "determining whether a user of the speech interaction session application is logged-in" if the "if the computer is not in the power-on state". This limitation is not disclosed in the specification as originally filed (see Fig. 6, steps 660 and 665 which actually contradict the limitation) and will not be given any patentable weight.

Claim 27 is similar to claim 21 and suffers from the same deficiencies. The other claims depend on either claim 21 or claim 27.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 21-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites "determining whether a time period between the predefined switch has been set to the second state exceeds a threshold". It is unclear what the time period represents and how it is determined. Claim 21 further discloses "a threshold for the computer remaining in the power-on state without key activity" if the "if the computer is not in the power-on state". It is unclear how there can be a threshold representing the time the computer is in power-on state without key activity when the computer is not in the power-on state. These limitations will not be given any patentable weight.

Claim 27 is similar to claim 21 and suffers from the same deficiencies. The other claims depend on either claim 21 or claim 27.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 27-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 27-30 are directed to a computer readable medium which, in accordance with Applicant's specification, may be an electromagnetic signal (Applicant's specification, [00120]). This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, a machine, a manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture or a machine, and not a composition of two or more substances to constitute a composition of matter.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 21, 22, 27, 28, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keely et al (USPN 6,791,536) in view of Schmid et al (US PGPub 2003/0234818).

Claim 21:

Keely discloses a computer-implemented method comprising:

receiving a signal indicating that a predetermined switch has been set to a first state ("detecting the stylus being placed down, the computer 201 may begin counting time, e.g., by using a timer, up to at least a threshold amount of time", col. 5, lines 62-65);

receiving a signal indicating that the predefined switch has been set to a second state ("When the stylus 204 is eventually removed from the display surface 202 (hereafter referred to as "bringing the stylus up"", col. 6, lines 17-23);

wherein, if the computer is in a power-on state (note the computer needs to be on in order to detect the stylus), initiate a new session comprising:

receiving a signal indicating that a predetermined switch has been set to a first state ("detecting the stylus being placed down, the computer 201 may begin counting time, e.g., by using a timer, up to at least a threshold amount of time", col. 5, lines 62-65);

monitoring a time parameter indicative of a time the switch remains in the first state ("the computer 201 may begin counting time", col. 5, lines 62-65).

Keely does not explicitly disclose canceling a speech interaction session if the time parameter exceeds a threshold.

Keely discloses performing an action related to a computer application (generating an event) in response to a time parameter exceeding a threshold. The limitation in the claim not explicitly recited in Keely is the fact that the action related to a computer application is cancelling a speech enabled application, i.e. Keely does not

explicitly teach cancelling a speech enabled application as an intended use for the disclosed invention for performing a computer action in response to a time parameter exceeding a threshold. Therefore the only feature missing in Keely in order to read on Applicant's limitation is cancelling a program related to a speech application.

Schmid discloses cancelling a program related to a speech application ("The "Shutdown" method is utilized to shut down the speech system", [0029]).

Simple substitution of one known computer step (Keely's generating an event) for another (Schmid's cancelling a speech application) to obtain the predictable result of cancelling a speech application in response to a time parameter exceeding a threshold would have been obvious to one with ordinary skill in the art at the time of Applicant's invention.

Further Keely and Schmid do not explicitly disclose wherein setting the predetermined switch comprises pressing a specified sequence of keys on a keyboard. However, Keely discloses entering commands using a keyboard (col. 4, lines 39-43) and Official Notice is taken that pressing a specified sequence of keys on a keyboard in order to enter commands into a computer is old and well known. For example, the Ctrl+Alt+Delete key combination is an old and well known method to end any current task.

Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to have set Keely's switch (a computer command) by pressing a

specified sequence of keys on a keyboard in order to control the computer using different input devices (see Keely, col. 4, lines 39-43).

Claim 22:

Keely and Schmid disclose the method of claim 21, Keely further discloses wherein monitoring a time parameter indicative of a time the switch remains in the first state comprises starting a timer in response to the signal ("detecting the stylus being placed down, the computer 201 may begin counting time, e.g., by using a timer, up to at least a threshold amount of time", col. 5, lines 62-65).

Claims 27, 28 and 31:

Keely and Schmid disclose the method of claims 21 and 22, Keely further discloses computer readable media comprising logic instructions which, when executed by a processor, configure the processor to perform the methods of claims 21 and 22 (col. 4, lines 24-34) wherein the computer-readable media comprises at least one of an electronic memory module, a magnetic memory module, and an optical memory module (col. 4, lines 24-34).

12. Claims 23-26, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keely et al (USPN 6,791,536) in view of Schmid et al (US PGPub 2003/0234818) and in further view of Labiaga et al (USPN 6,185,615).

Claim 23:

Keely and Schmid disclose the method of claim 22, Keely further discloses setting a flag indicating that the switch is in the first state (col. 5, lines 62-65); but Keely

and Schmid do not explicitly disclose recording a time stamp indicative of a time at which the signal is received.

In a system producing computer transactions logs, Labiaga discloses recording a time stamp as a result of an event (col. 11, lines 23-26).

It would have been obvious to one with ordinary skill in the art at the time of the invention to track event duration in Keely's method using timestamps because they are old and well-known time signatures generated using the system clock of a computer.

Claim 24:

Keely, Schmid, and Labiaga disclose the method of claim 23, wherein the time stamp corresponds to a signal clock time (clock time is inherent in timestamp).

Claim 25:

Keely, Schmid, and Labiaga disclose the method of claim 23, Labiaga further discloses wherein canceling the speech interaction session if the time parameter exceeds a threshold comprises: monitoring a state of the switch; and canceling the speech interaction session if a result of subtracting the time stamp from a current system time exceeds a threshold (Labiaga, col. 11, lines 30-33).

Claim 26:

Keely, Schmid, and Labiaga disclose the method of claim 25, Labiaga further discloses maintaining an operation log in a system memory (col. 4, lines 26-31) and recording in the operation log any changes made to data files during the speech interaction session (col. 4, lines 26-31); however, Keely, Schmid, and Labiaga do not

explicitly disclose wherein canceling the speech interaction session comprises reversing any operations performed during the speech interaction session.

It is admitted prior art (see Final Rejection mailed on 14 April 2009) that resetting an application to its default state is old and well known in the computing arts.

It would have been obvious to one with ordinary skill in the art at the time of the invention to reset the speech interaction session in Keely, Schmid, and Labiaga's method in order to avoid entangling the program with previous data and computations.

Claims 29 and 30:

Keely and Schmid disclose the method of claims 23 and 24, Keely further discloses computer readable media comprising logic instructions which, when executed by a processor, configure the processor to perform the methods of claims 1 and 2 (col. 4, lines 24-34).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMUEL G. NEWAY whose telephone number is (571)270-1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R Hudspeth/
Supervisory Patent Examiner, Art Unit 2626

/S. G. N./
Examiner, Art Unit 2626